

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Genty et al.	:
	: Before the Examiner:
Serial No: 09/981,878	: Dennis G. Bonshock
	:
Filed: 10/18/2001	: Group Art Unit: 2173
	:
Title: APPARATUS AND METHOD	: Confirmation No.: 7330
OF VISITING BOOKMARKED WEB	:
PAGES WITHOUT OPENING A	:
BOOKMARK FOLDER	:

SUBSTITUTE APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Substitute Appeal Brief is in response to the NOTICE OF NON-COMPLIANT APPEAL BRIEF of December 14, 2006.

BRIEF FOR APPLICANTS - APPELLANTS

(I)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(II)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(III)

Status of Claims

Claims 1, 4 – 6, 9 – 11, 14 – 16 and 19 – 29 have been finally rejected in an Office Action dated June 01, 2005. In that Office Action, the Examiner objected to the claims because the "W" in the word "Web" was sometimes capitalized and at times not. In a telephone conversation on August 02, 2005, the Examiner has agreed to enter an Examiner's Amendment in which the word "Web" will be written with a capital "W" in all the claims to overcome the objection. The Examiner's Amendment will be entered in the Examiner's Reply Brief.

Claims 2, 3, 7, 8, 12, 13, 17 and 18 were canceled. Claims 1, 4 – 6, 9 – 11, 14 – 16 and 19 – 29 are being appealed.

(IV)

Status of Amendments

No amendment was filed subsequent to the Final Rejection.

(V)

Summary of Claimed Subject Matter

The invention, as claimed in independent Claim 1, provides a method of accessing and displaying a plurality of bookmarked web pages. The bookmarked Web pages are arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed. The method comprises the steps of activating a browser for a first time in a day, wherein, upon activation, the browser has at least one icon associated with the first one of the bookmarked web pages in the sequence; and asserting the at least one icon for accessing and displaying said the first one of said bookmarked Web pages (see page 11, lines 19 – 27, page 12, lines 3 – 6).

The invention, as claimed in independent Claim 6, provides a computer program product on a computer readable medium for accessing and displaying a plurality of bookmarked web pages. The bookmarked Web pages are arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed. The computer program product comprises code means for activating a browser for a first time in a day, wherein, upon activation, the browser has at least one icon associated with the first one of the bookmarked web pages in the sequence; and asserting the at least one icon for accessing and displaying said the first one of said bookmarked Web pages (see page 11, lines 19 – 27, page 12, lines 3 – 6). The code means are the steps outlined on page 13, line 9 to page 14, line 17 (see also Fig. 10).

The invention, as claimed in independent Claim 11, provides an apparatus for accessing and displaying a plurality of bookmarked web pages. The bookmarked Web pages are arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed. The apparatus comprises means for activating a browser for a first time in a day, wherein, upon activation, the browser has at least one icon associated with the first one of the bookmarked web pages in the sequence; and asserting the at least one icon for accessing and displaying said the first one of said bookmarked Web pages (see AUS920010860US1

page 11, lines 19 – 27, page 12, lines 3 – 6). The means are the steps outlined on page 13, line 9 to page 14, line 17 when processed by processor 202, 204 of Fig. 2 or 302 of Fig. 3.

The invention, as claimed in independent Claim 16, provides a computer system for accessing and displaying a plurality of bookmarked web pages. The bookmarked Web pages are arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed. The computer system comprises at least one memory device for storing code data (see local memory 209, hard disk 232 of Fig. 2 main memory 304, disk 326, tape 328 or CD-ROM 330 of Fig. 3), a processor (see processor 202, 204 or 302) for processing the code data to activate a browser for a first time in a day, wherein, upon activation, the browser has at least one icon associated with the first one of the bookmarked web pages in the sequence; and to assert the at least one icon for accessing and displaying said the first one of said bookmarked Web pages (see page 11, lines 19 – 27, page 12, lines 3 – 6).

The invention, as claimed in Claim 29, provides a method of bookmarking a plurality of web pages such that the plurality of the bookmarked web pages can be accessed without opening a bookmark folder in which the plurality of bookmarked web pages (page 3, lines 3 – 5). The method comprises the steps of bookmarking the plurality of bookmarked Web pages by storing the plurality of bookmarked Web pages into the bookmark folder (page 11, lines 13 – 18), the plurality of bookmarked Web pages being stored in the bookmark folder in a sequence in which the bookmarked Web pages are to be accessed (page 3, lines 3 – 6); enabling an icon in a browser to be associated with the first bookmarked Web page in the sequence; enabling the icon upon being asserted to access and display the associated bookmarked Web page; and allowing the icon to be asserted upon instantiation of the browser, the icon, after accessing and displaying an associated bookmarked Web page, is disassociated with the displayed bookmarked Web page and is associated with a next bookmarked Web page in the sequence (page 11, line 19 – 24).

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(VI)

Grounds of Rejection to be Reviewed on Appeal

Whether Claims 1, 4 – 6, 9 – 11, 14 – 16 and 19 - 28 were properly rejected under 102(e) as being anticipated by Bauersfeld et al.

Whether Claim 29 was properly rejected under 102(e) as being anticipated by Bauersfeld et al.

(VII)

Arguments

Whether Claims 1, 4 – 6, 9 – 11, 14 – 16 and 19 - 28 were properly rejected under 102(e) as being anticipated by Bauersfeld et al.

Bauersfeld et al. purport to teach a session navigation and recording system for generating user defined paths. In accordance with the purported teachings of Bauersfeld et al., as a user navigates through the Internet, the user may elect to have the Web pages that are being accessed bookmarked for later retrieval. These bookmarked Web pages are stored in a session file folder. Generally, a default session file folder, having for name the current date, is used for storing the bookmarked Web pages. The user may, at any time, change the name of the default session file folder to any other name. The default session file folder is normally empty when the user instantiates the browser for the first time in a day. The session file folder does not start to fill up until the user has started to navigate through the Internet.

After activating the browser, the user may revisit a previously stored set of bookmarked web pages. To do so, the user needs to replace the default session file folder with a session file folder into which the set of bookmarked Web pages was previously stored. The user can do so by selecting, using a pull down menu of a session tool bar, the desired session file folder. Once that is done, the user

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may access the bookmarked Web pages by asserting a BACK or a FORWARD button on the session tool bar.

Thus, Bauersfeld et al. do not teach or suggest the steps of ***activating a browser for a first time in a day, wherein the browser, upon activation, has at least one icon associated with the first one of the bookmarked web pages in the sequence; and of accessing and displaying the first one of the bookmarked Web pages by asserting the icon*** as claimed (see representative Claim 1). Rather, Bauersfeld et al. arguably teach that the user has to make that association by choosing a session file folder that contains a set of bookmarked Web pages or that the user has to begin to navigate through the Internet before the association occurs.

It is a well settled law that in considering a Section 102 rejection, all the elements of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985); *Atlas Powder Co. v. Dupont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *American Hospital Supply v. Travenol Labs.*, 745 F.2d 1, 223 USPQ 577 (Fed. Cir. 1984).

Since Bauersfeld et al. does not teach the invention as claimed, Applicants submit that the claims are allowable.

Whether Claim 29 was properly rejected under 102(e) as being anticipated by Bauersfeld et al.

Claim 29 includes the limitations of bookmarking the plurality of bookmarked Web pages by storing the plurality of bookmarked Web pages into the bookmark folder, the plurality of bookmarked Web pages being stored in the bookmark folder in a sequence in which the bookmarked Web pages are to be accessed; enabling an icon in a browser to be associated with the first bookmarked Web page in the sequence; enabling the icon upon being asserted to access and display the associated bookmarked Web page; and allowing the icon to be asserted upon instantiation of the browser, the icon, after

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accessing and displaying an associated bookmarked Web page, is disassociated with the displayed bookmarked Web page and is associated with a next bookmarked Web page in the sequence.

The Examiner does not assert that the applied reference teach the claimed limitations of **allowing the icon to be asserted upon instantiation of the browser**. Consequently, Applicants submit that the Examiner failed to provide a prima facie rejection of the claim. Hence the claim is patentable over the reference.

Based on the foregoing, Applicants kindly request allowance and passage to issue of the claims in the application.

Respectfully Submitted

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(VIII)

Claims Appendix

1. (Previously presented) A method of accessing and displaying a plurality of bookmarked web pages, the plurality of bookmarked Web pages being arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed, the method comprising the steps of:

activating a browser for a first time in a day, said browser, upon activation, having at least one icon associated with the first one of said bookmarked web pages in the sequence; and

asserting said at least one icon for accessing and displaying said first one of said bookmarked Web pages.

2. Canceled.
3. Canceled.
4. (Previously presented) The method of Claim 22 wherein the at least one icon is a next icon.
5. (Previously presented) The method of Claim 4 wherein the other icon is a previous icon.
6. (Previously presented) A computer program product on a computer readable medium for accessing and displaying a plurality of bookmarked web pages, the plurality of bookmarked Web pages being arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed, the computer program product comprising:

code means for activating a browser for a first time in a day, said browser, upon activation, having at least one icon be associated with the first one of said bookmarked web pages in the sequence; and

code means for asserting said at least one icon for accessing and displaying said first one of said bookmarked Web pages.

7. Canceled.
8. Canceled.
9. (Previously presented) The computer program product of Claim 24 wherein the at least one icon is a next icon.
10. (Previously presented) The computer program product of Claim 9 wherein the other icon is a previous icon.
11. (Previously presented) An apparatus for accessing and displaying a plurality of bookmarked web pages, the plurality of bookmarked Web pages being arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed, the apparatus comprising:

means for activating a browser for a first time in a day, said browser, upon activation, having at least one icon be associated with the first one of said bookmarked web pages in the sequence; and

means for asserting said at least one icon for accessing and displaying said first one of said bookmarked Web pages.

12. Canceled.
13. Canceled.
14. (Previously presented) The apparatus of Claim 26 wherein the at least one icon is a next icon.
15. (Previously presented) The apparatus of Claim 14 wherein the other icon is a previous icon.
16. (Previously presented) A computer system for accessing and displaying a plurality of bookmarked web pages, the plurality of bookmarked Web pages being arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed, the computer system comprising:

at least one memory device for storing code data; and

a processor for processing said code data to activate a browser for a first time in a day, said browser, upon activation, having at least one icon be associated with the first one of said bookmarked web pages in the sequence, and to assert said at least one icon for accessing and displaying said first one of said bookmarked Web pages.
17. Canceled.
18. Canceled.
19. (Previously presented) The computer system of Claim 28 wherein the at least one icon is a next icon.

20. (Previously presented) The computer system of Claim 19 wherein the other icon is a previous icon.
21. (Previously presented) The method of Claim 1 wherein after accessing a previous one of the bookmarked Web pages in the sequence, the at least one icon becomes associated with a succeeding one of the bookmarked Web pages in the sequence.
22. (Previously presented) The method of Claim 21 wherein after accessing the previous one of the bookmarked Web pages, the previous one of the bookmarked web pages becomes associated with another icon.
23. (Previously presented) The computer program product of Claim 6 wherein after accessing a previous one of the bookmarked Web pages in the sequence, the at least one icon becomes associated with a succeeding one of the bookmarked Web pages in the sequence.
24. (Previously presented) The computer program product of Claim 23 wherein after accessing the previous one of the bookmarked Web pages, the previous one of the bookmarked web pages becomes associated with another icon.
25. (Previously presented) The apparatus of Claim 11 wherein after accessing a previous one of the bookmarked Web pages in the sequence, the at least one icon becomes associated with a succeeding one of the bookmarked Web pages in the sequence.

26. (Previously presented) The apparatus of Claim 25 wherein after accessing the previous one of the bookmarked Web pages, the previous one of the bookmarked web pages becomes associated with another icon.
27. (Previously presented) The computer system of Claim 16 wherein after accessing a previous one of the bookmarked Web pages in the sequence, the at least one icon becomes associated with a succeeding one of the bookmarked Web pages in the sequence.
28. (Previously presented) The computer system of Claim 27 wherein after accessing the previous one of the bookmarked Web pages, the previous one of the bookmarked web pages becomes associated with another icon.
29. (Previously presented) A method of bookmarking a plurality of web pages such that the plurality of the bookmarked web pages can be accessed without opening a bookmark folder in which the plurality of bookmarked web pages are stored comprising the steps of:

bookmarking the plurality of bookmarked Web pages by storing the plurality of bookmarked Web pages into the bookmark folder, the plurality of bookmarked Web pages being stored in the bookmark folder in a sequence in which the bookmarked Web pages are to be accessed;

enabling an icon in a browser to be associated with the first bookmarked Web page in the sequence;

enabling the icon upon being asserted to access and display the associated bookmarked Web page; and

allowing the icon to be asserted upon instantiation of the browser, the icon, after accessing and displaying an associated bookmarked Web page, is disassociated with the displayed bookmarked Web page and is associated with a next bookmarked Web page in the sequence.

(IX)

Evidence Appendix

No evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 and 1.132 nor was there any evidence entered by the Examiner relied upon by Appellants in this appeal.

(X)

Related Proceedings Appendix

There are no decisions rendered by a court or the Board that would have a bearing on the Board's decision in the pending appeal.